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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/068,411	02/06/2002	Jamie J. McNutt	P99047US2A	4690
7590	04/05/2004		EXAMINER	
Bridgestone/Firestone Americas Holding, Inc. Chief Intellectual Property Counsel 1200 Firestone Parkway Akron, OH 44317-0001				WYROZEBSKI LEE, KATARZYNA I
		ART UNIT	PAPER NUMBER	1714

DATE MAILED: 04/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/068,411	MCNUTT ET AL. <i>[Handwritten signature]</i>
	<b>Examiner</b>	<b>Art Unit</b>
	Katarzyna Wyrozebski Lee	1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 02 February 2004.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 16 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-15 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                     | Paper No(s)/Mail Date. _____ .  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____ .                                  |

In view of the applicants response to the amendment mailed on 2/2/2004 following office action is final.

***Election/Restrictions***

In view of applicant's argument, the restriction requirement is considered final. Applicant's request for rejoinder will be considered once the application is in condition for allowance and only if restricted claim 16 contains all the allowable subject matter of independent elected claims.

***Claim Rejections - 35 USC § 112***

In view of applicant's arguments 112 rejections of record are overcome.

***Claim Rejections - 35 USC § 102***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-15 are rejected under 35 U.S.C. 102(b) as being anticipated by LAUBE (US 5,426,147) in view of evidence in KITAHARA (US 4,525,541).

The discussion of the disclosure of the prior art of LAUBE from paragraph 11 of the office action mailed on 10/29/2003 is incorporated here by reference.

In the response to the non-final office action the applicants raised following issues:

- a) The rejection of record is not proper since it relies on teaching of two references.

With respect to the above argument, the examiner would like to point the applicants to the form paragraph. The prior art of LUBE is utilized alone. The disclosure of KATIHARA is utilized as evidence instead of examiner's taking official notice or stating that something is well known in the art.

- b) The rejection over the prior art of LAUBE is not proper since the prior art of LAUBE does not teach bead area but inner liner. The applicants further went into explanation why the bead filler composition is different from inner liner in properties such as heat resistance and flax resistance.

With respect to the above argument, col. 1, lines 25-27 the prior art of LAUBE discloses that properties such as heat resistance and flex resistance are also properties important to the inner liners. They are not only important for the bead filler area. In addition col. 23, lines 8-24 discloses rubber that can be utilized in the disclosure of LAUBE that include SBR, BR, IR, chloroprene, halogenated rubber and the mixtures of those rubbers. There is nothing in the prior art of LAUBE that says you have to have halogenated rubber in the composition and that you can not pick, for example, SBR.

At the same time, the applicants claim call for virtually any rubber that can be formed from conjugated diene and its copolymers with vinyl aromatic.

c) The compositions cannot necessarily be used interchangeable within a tire. This argument is based on the different grades of the carbon black in the rubber compositions.

With respect to the encyclopedia pages that the applicants submitted, the examiner did not find any pages that would be specific to the bead filler and that would show that use of such carbon blacks is specific to only these types of carbon black. In addition it is examiner's position that the encyclopedia shows one of the thousands examples of the rubber compositions that are possible. The examples provided by the applicant are further contrary to the prior art of LAUBE that discloses different carbon black. Therefore applicants' arguments at this point are not persuasive. The examiner would like the applicants to further clarify term "cannot necessarily" form last sentence of page 3 of their response.

Therefore in view of the above arguments and further in view of evidence in KATIHARA, making bead fillers and inner liners from the same composition of LAUBE would be otherwise well known to one skilled in the art.

### ***Priority Information***

With respect to the priority information on the first page of the specification, the applicants should make an update indicating that the parent application is now abandoned.

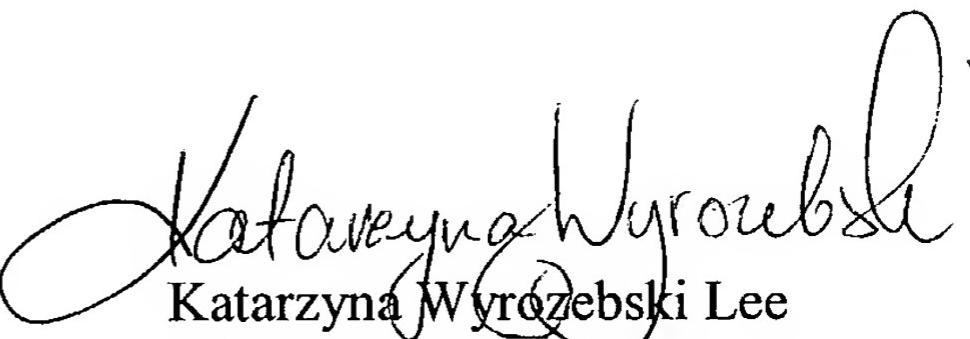
2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katarzyna Wyrozebski Lee whose telephone number is (571) 272-1127. The examiner can normally be reached on Mon-Thurs 6:30 AM-4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Katarzyna Wyrozebski Lee  
Primary Examiner  
Art Unit 1714

kiwl  
March 31, 2004